Rejection of Claim 12 Under 35 U.S.C. §102(e) as Being Unpatentable Over Shurling et al.

Claim 12 is directed to leveraging a relationship between a customer and a financial institution, wherein two types of value, immediate access value and vested access value, are added to **the same financial account** at the financial institution at predetermined intervals. The immediate access value is added to the financial account by the customer and the customer controls the amount and the predetermined intervals. The vested access value is added to the financial account by the financial institution according to the limitations set forth in claim 12. Shurling et al. does not teach or suggest the combination of limitations set forth in claim 12. At most, the reward system set forth in Shurling et al. discloses the submission of value by the financial institution or the sponsor into an account. There is no discussion in either reference of separate types of value, immediate access and vested access, inputted into **the same financial account** by and under the control of separate entities, the customer and the financial institution. More particularly, claim 12 requires the following limitation "and further wherein the immediate access value is added to the first financial account by **the customer**, in an amount determined **by the customer** and at the direction **of the customer**." (Claim 12)(emphasis added). As in previous Office Actions, the Examiner once again points specifically to Column 3, lines 12-26 of Shurling et al. as disclosing the "immediate access value" limitation of claim 12. At the risk of being redundant, the undersigned representative once again sets forth this portion of Shurling et al. in its entirety in order to show that the language found in Column 3, lines 12-26 in fact teaches away from the limitations "immediate access value:"

> Still another significant aspect of this invention is a Relationship scoring and Incentive Reward awarding process that automatically determines a customer's entitlement to the Incentive Rewards. In accordance with this aspect of the invention a **vesting relationship** or percentage is automatically determined from the Relationship score and the Incentive

> Rewards are awarded accordingly. Also in accordance with this aspect of the invention the Incentive Rewards may be automatically awarded to the customer by adjusting information in the customer information file. Examples of information that may be adjusted to award Incentive Rewards are loan and deposit account interest rates and bank service fees. Further in accordance with this aspect of the invention, the relationship between Relationship score and the **vesting of Incentive Rewards** may be established or changed to meet the requirements of the Bank.

(emphasis added). This paragraph does not describe immediate access value that is determined and added to an account at the direction of the customer. On the contrary, this paragraph describes vested access value, which is not controlled by the customer, but rather is determined through an awarding process.

In the most recent Office Action, the Examiner now additionally cites to the field of the invention section of Shurling et al., i.e., Col. 1, l. 18, in order to support his rejection. This section of the patent defines, for purposes of reading the patent, what certain terms recited in the patent mean. For example, Col. 1, ll. 15-18 states "'Relationship' is intended to mean each type of financial transaction, account or interaction which the customer may establish with the Bank, such as a checking account, savings account, … ." The undersigned representative fails to see how this definition meets the limitation of claim 12. Further, the undersigned representative fails to see how this recitation even supports the Examiner's own interpretation of Col. 1, line 18, "'checking account' which contains value immediately accessible to customer and deposited and controlled by customer." Establishing a checking account with a bank by no means meets the limitations set forth in claim 12.

Further, independent claim 12 discloses both immediate and vested access value that is stored in the same financial account. Consequently, even if Shurling et al., does meet the limitations of claim 12 regarding immediate access value, Shurling et al. does not teach or

suggest that the same account that holds the immediate access value also holds vested access value. The Examiner appears to make an attempt to establish that "reduced banking fees" are equivalent to vested access value. The undersigned representative understands that reduced banking fees can be a reward as defined in Shurling et al. A review of the specification and the language of the claims clearly defines "value" with in the context of the present application to be funds. In fact, the systems described in the present application are referred to as "funding engines." The undersigned representative fails to see how the description of reduced banking fees as a reward in Shurling et al. meets the limitations drawn to **vested access value** that is **added** to **the same financial account** as the immediate access value that is **retrievable** by the customer after a predetermined period of time. In order to establish a *prima facie* case of unpatentability, the Patent Office must show the following: (1) suggestion or motivation to modify the reference or to combine the reference teachings; (2) a reasonable expectation of success; and (3) **the prior art reference or references must teach or suggest all of the claim limitations**. See MPEP §2142.

Since Shurling et al. fails to disclose at least those limitations specifically addressed above, the Examiner has failed to establish a *prima facie* case of unpatentability with regard to independent claim 12. As claims 16-22 include all of the limitations of claim 12, these claims are also allowable over Shurling et al.

Rejection of Claims 3-6, 9-11, and 16-23 Under 35 U.S.C. §103(a) as Being Unpatentable Over Shurling et al. in View of Ferguson et al.

Claim 3 is directed to rewarding customers based on the customer's relationships with both a financial institution and at least one third party. Further, information about these relationships is collected from each of the customer, the financial institution, and the at least one

third party. Again, at the risk of sounding redundant, as stated in previous responses, the primary reference, Shurling et al., discloses a customer loyalty program that is implemented by a bank. The bank rewards customers for their loyalty based on information received from the customer and information generated within the bank with regard to the customer's relationship with the bank. The bank does not collect relationship information, nor does the back consider relationship information from any third party in determining a customer's reward. Consequently, Shurling et al., does not meet the recitations of claim 3 as presented herein.

Further, the secondary reference, Ferguson et al., does not cure the deficiencies of Shurling et al. Ferguson et al. describe a patronage incentive system wherein a customer is rewarded based on transactions made with a sponsor. Initially, Ferguson et al. do not teach or suggest "collecting financial relationship information separately from each of the customer, the financial institution, and the at least one third party." Second, Ferguson et al. do not teach or suggest evaluating the financial relationship between the customer and the third party based on the collected relationship information. Third, in making a reward determination for the customer, Ferguson et al. do not teach or suggest that the sponsor considers information about relationships that the customer has with one or more third parties. The sponsor rewards the customer based on the transactions that the sponsor has with the customer. Independent claim 3 requires three separate entities, collection of relationship information from these three separate entities and evaluation of the relationship information between these three separate entities where a relationship has been defined. At most, Shurling et al. describes relationship information collection and evaluation by and between only 2 entities. Similarly, at most, Ferguson et al. describes relationship information collection and evaluation by and between only 2 entities.

Neither reference suggests information collection from a third entity. And as such, there can be no relationship evaluation between three entities as is set forth in the claims.

Consequently, neither Shurling et al. nor Ferguson et al., either alone or in combination, disclose or suggest the combination of limitations recited in claim 3. The undersigned representative respectfully submits that claim 3 and dependent claims 4-6 and 9-11 are allowable over the cited prior art.

With regard to the Examiner's rejection of independent claim 23, again, the Examiner has failed to provide a reference wherein there are three entities interacting in the fashion set forth in claim 23. More specifically, neither Shurling et al. nor Ferguson et al., either alone or in combination, describe the step of negotiating a value factor with at least one third-party, wherein the at least one third-party contributes future access value to a customer account. In fact, neither reference describes the negotiation of any value factor by any entity. Since neither reference teaches this limitation, no combination of Shurling et al. and Ferguson et al. can establish a *prima facie* case of unpatentability under 35 U.S.C. § 103.

CONCLUSION

The undersigned representative respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution might be advanced by discussing the application with the undersigned representative, in person or over the telephone, we welcome the opportunity to do so.

Respectfully submitted,

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